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THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 18

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PAT & TM OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROXY N. FAN and REID E. KELLOGG

Appeal No. 95-0583
Application 07/926,887¹

ON BRIEF

Before JOHN D. SMITH, GARRIS and PAK, Administrative Patent Judges.

GARRIS, Administrative Patent Judge.

DECISION ON APPEAL

¹ Application for patent filed August 7, 1992.

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This is a decision on an appeal from the final rejection of claims 1, 3-7, 9-17 and 20-22² which are all of the claims remaining in the application.

The subject matter on appeal relates to a process for preparing a relief image and to a photosensitive element used for preparing a relief image. This appealed subject matter is adequately illustrated by independent claims 1 and 22, a copy of which taken from the main brief is appended to this decision.

The references relied upon by the examiner as evidence of obviousness are:

Alles	3,458,311	Jul. 29, 1969
Oransky et al. (Oransky)	4,245,003	Jan. 13, 1981
Sato et al. (Sato)	4,624,891	Nov. 25, 1986
Gibson, Jr. et al. (Gibson)	5,085,976	Feb. 4, 1992
Shaw et al. (Shaw)	5,192,641	Mar. 9, 1993
		(Filed Dec. 19, 1990)
Japanese Kokai Patent (Hayashi)	118,842	May 11, 1989

² We observe that the reproductions of appealed claims 3 and 4 in the main brief incorrectly reflect that these claims depend from claim 1. In fact, claims 3 and 4 depend from now canceled claim 2, and this informality should be corrected in any further prosecution that may occur.

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The rejections before us on this appeal are set forth below.³

Claims 1, 4, 5, 7, 9, 10, 21 and 22 are rejected under 35 U.S.C. § 102(b) as being anticipated by or alternatively under 35 U.S.C. § 103 as being obvious over Hayashi.

Claims 1, 3-5, 7, 9, 10, 21 and 22 are rejected under 35 U.S.C. § 102(e) as being anticipated by or alternatively under 35 U.S.C. § 103 as being obvious over Shaw.

Claims 6, 11-17 and 20 are rejected under 35 U.S.C. § 103 as being obvious over Hayashi taken with Gibson.

Claims 1, 3-5, 7, 9, 10, 21 and 22 are rejected under 35 U.S.C. § 103 as being obvious over Shaw in view of Sato taken with Oransky.

Claims 3 and 17 are rejected under 35 U.S.C. § 103 as being obvious over Hayashi in view of Shaw.

³ The examiner has withdrawn the double-patenting rejections based upon the claims of U.S. Patent No. 5,262,275 (see the supplemental examiner's answer mailed May 26, 1994 (paper no. 17)).

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Finally, claim 22 is rejected under 35 U.S.C. § 103 as being obvious over Hayashi in view of Alles.

As a preliminary matter, we note that the appealed claims will stand or fall together as grouped respectively in each of the above noted rejections; see pages 6 and 7 of the main brief and 37 CFR 1.192(c) (7).

We will sustain each of the examiner's prior art rejections of claims 20-22 which are directed to a photosensitive element used for preparing a relief image. However, we will not sustain any of the examiner's prior art rejections of claims 1, 3-7 and 9-17 which are drawn to a process for preparing a relief image. Our reasons are set forth below.

We agree with the appellants that neither Hayashi nor Shaw contains any teaching or suggestion concerning step (5) of independent process claim 1 on appeal. This step requires "developing the product of step (4) by treatment with a developer solvent to remove (i) the areas of the photosensitive layer which are more soluble and (ii) the part of layer (c) adhering to the photosensitive layer (b)." While the respective processes of

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these references remove soluble areas of the photosensitive layer with a developer solvent as required by part (i) of this step, neither of these references discloses or would have suggested use of a developer solvent to remove "the part of layer (c) adhering to the photosensitive layer (b)" as required by part (ii) in step (5) of the here claimed process. Rather, in each of Hayashi and Shaw, the layer or film which corresponds to the appellants' claimed "the part layer (c) adhering to the photosensitive layer (b)" is peeled off. That is, the prior art layer or film is removed via a peeling step rather than a solvent treatment step.

Concerning these matters, the examiner points out that the process claims on appeal do not exclude a peeling step. While this may be true, it begs the issue of whether either Hayashi or Shaw teaches or would have suggested treatment with a developer solvent to remove "the part of layer (c) adhering to the photosensitive layer (b)" as required by the appellants' process claims. In the "Response to argument" section of the main answer, the examiner seems to urge that this requirement or limitation "does not apply" (i.e., should be ignored?) because

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the appealed process claims encompass the presence of a barrier layer between layers (b) and (c) whereby no part of layer (c) would be adhered directly in contact with the photosensitive layer (b). This viewpoint of the examiner is misfocused.

Contrary to his implicit belief, the recitation in step (5) of the independent process claim on appeal does not require direct adherence, and thus encompasses indirect adherence of a part of layer (c) to photosensitive layer (b). For this reason, the fact that the appellants' process claims encompass the aforementioned presence of a barrier layer between layers (b) and (c) does not support the examiner's position that "[t]he limitation of the removal of the portion of the masking layer [i.e., layer (c)] adhering to the photosensitive layer [i.e., layer (b)]...does not apply [and therefore should be ignored?]" (answer, page 13).

In light of the foregoing, we cannot sustain the examiner's § 102(b)/§ 103 rejections of process claims 1, 4, 5, 7, 9 and 10 over Hayashi or his § 102(e)/§ 103 rejections of process claims 1, 3-5, 7, 9 and 10 over Shaw. The other references applied in the remaining rejections of the process claims on appeal have not

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been relied upon by the examiner to supply the above discussed deficiencies of Hayashi and Shaw, and our independent study of these references indicates that they do not cure these deficiencies. As a consequence, we also cannot sustain the examiner's § 103 rejection of process claims 6 and 11-17 over Hayashi and Gibson or his § 103 rejection of process claims 1, 3-5, 7, 9 and 10 over Shaw in view of Sato and Oransky or his § 103 rejection of process claims 3 and 17 over Hayashi in view of Shaw.

As indicated previously, we reach a different conclusion regarding appealed claims 20-22 which are directed to a photosensitive element used for preparing a relief image. Concerning these claims, the appellants argue that neither Hayashi nor Shaw contains any teaching or suggestion of a "barrier layer which is soluble, swellable, dispersible or liftable in the developer solvent" as required by their independent claim 22. We cannot agree. As correctly observed by the examiner, this requirement is satisfied by the above discussed peelable layer or film disclosed in each of these

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references. More particularly, the fact that the prior art layer or film is peelable evinces that it would be inherently "liftable in the developer solvent", and the appellants have not carried their burden of proving otherwise. In re Best, 562 F.2d 1252, 1255, 195 USPQ 430, 433-434 (CCPA 1977) (PTO can require applicant to prove that prior art products do not inherently possess characteristics of claimed product, and whether rejection is under § 102 or § 103 the fairness of this burden of proof is evidenced by the PTO's inability to manufacture products or to obtain and compare prior art products).

In short, the only feature of appealed claims 20-22 which the appellants argue as a distinction is, from our perspective, inherently possessed by Hayashi or Shaw. For this reason alone, it is appropriate to sustain the examiner's § 102(b)/§ 103 rejections of element claims 21 and 22 over Hayashi, his § 102(e)/§ 103 rejections of element claims 21 and 22 over Shaw, his § 103 rejection of element claim 20 over Hayashi and Gibson, his § 103 rejection of element claims 21 and 22 over Shaw in view

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of Sato and Oransky and his § 103 rejection of element claim 22 over Hayashi in view of Alles.⁴

In summary, we have sustained the aforementioned § 102 and § 103 rejections of photosensitive element claims 20-22 but not the § 102 or § 103 rejections of process claims 1, 3-7 and 9-17.

The decision of the examiner is affirmed-in-part.

⁴ The § 103 rejection of independent claim 22 over Hayashi and Alles is based upon the examiner's position that "[i]t would have been obvious to one skilled in the art to substitute the [solvent soluble or swellable] protective layers taught by Alles for those taught by JP01-118842 [i.e., Hayashi]" (answer, page 11). We emphasize, however, that our decision to sustain this rejection is based solely upon our conclusion that the peelable layer of Hayashi is inherently "liftable in the developer solvent" as required by the rejected claim. We decline to assess the examiner's obviousness position for two reasons. First, in formulating this rejection and his concomitant obviousness conclusion, the examiner has not clearly identified which layer of Hayashi's photosensitive element would have been replaced by an ordinarily skilled artisan with a solvent soluble or swellable protective layer of the type taught by Alles. Second, the examiner's answers do not contain a response to the appellants' arguments as to why it would not have been obvious to replace certain specific layers of Hayashi with the protective layer of Alles.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

JOHN D. SMITH)
Administrative Patent Judge)

BRADLEY R. GARRIS
Administrative Patent Judge)

BOARD OF PATENT
APPEALS AND
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CHUNG K. PAK
Administrative Patent Judge)

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APPENDIX

1. A process for preparing a relief image which comprises:
 - (1) preparing an element having the following layers: (a) a support;
(b) a photosensitive layer comprising an initiator having sensitivity to non-infrared actinic radiation and at least one component that is capable of reacting with the initiator after the initiator has been activated by exposure to non-infrared actinic radiation; (c) at least one infrared radiation sensitive layer which is substantially opaque to non-infrared actinic radiation; and (d) a coversheet;
 - (2) exposing imagewise the element through layer (d) with infrared laser radiation;
 - (3) removing the layer (d) having adhered thereto a part of layer (c), wherein the remaining element consists of layers (a), (b) and a mask consisting of the part of layer (c) not adhered to layer (d);
 - (4) exposing overall the remaining element of step (3) with non-infrared actinic radiation through the mask to produce a change in solubility of the exposed photosensitive layer (b) thereby producing a solvent developable product; and
 - (5) developing the product of step (4) by treatment with a developer solvent to remove (i) the areas of the photosensitive layer which are more soluble and (ii) the part of layer (c) adhering to the photosensitive layer (b).

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22. A photosensitive element used for preparing a relief image comprising in the order listed:

(a) a support:

(b) a photosensitive layer comprising an initiator having sensitivity to non-infrared actinic radiation and at least one component that is capable of reacting with the initiator after the initiator has been activated by exposure to non-infrared actinic radiation, said photosensitive layer being soluble, swellable, dispersible or liftable in a developer solvent;

(b') a least one barrier layer which is soluble, swellable, dispersible or liftable in the developer solvent;

(c) at least one infrared radiation sensitive layer which is substantially opaque to non-infrared actinic radiation; and

(d) a coversheet which is removed after imagewise exposure to infrared laser radiation.